



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dzau et al. Docket No.: 39753-0021  
Serial No.: 09/839,752 Group Art Unit: 1636  
Filing Date: April 19, 2001 Examiner: Marvich, Maria  
For: THERAPEUTIC USE OF CIS-ELEMENT DECOYS IN VIVO

#19  
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JUN 02 2003  
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RESPONSE TO OFFICE ACTION

**Mail Stop: Box No-Fee Amendment**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Dear Sir:

This is in response to the Office Action mailed on February 25, 2003 in connection with the above-identified patent application, setting a three months term. The present response is accompanied by a Revocation and New Power of Attorney. The Examiner is respectfully requested to direct all future communications to the address indicated below, to the attention of the undersigned attorney.

Claims 13-16 are pending in this application. Claims 13, 14 and 16 have been rejected. Claim 15 has been objected to.

The basis of all rejections is that Applicants unintentionally failed to insert a priority claim under 35 U.S.C. §120 to parent Applications Serial Nos. 08/524,206 filed on September 8, 1995, and 08/144,717 filed on October 29, 1993, into the specification within the time limit provided in 37 C.F.R. §1.78(a)(2). As a result, the filing date of the present application (April 19, 2001) [erroneously referred to as April 19, 2002 in the Office Action] was considered to be

**CERTIFICATE OF MAILING (37 CFR 1.8(a))**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on May 23, 2003, with the U.S. Postal Service as first class mail in an envelope addressed to: **Mail Stop: No-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Date: May 23, 2003


*Cheryl Rogers*  
Cheryl Ann Rogers

the earliest priority date, and a series of references published before this date, but after October 29, 1993 were cited against the claims pending.

Concurrently with the present Response, Applicants filed an Amendment and Petition under 37 C.F.R. §1.78(a) to accept unintentionally delayed priority claim under 35 U.S.C. § 120, a copy of which is enclosed for the Examiner's convenience. It is believed that upon grant of the petition and entry the requested amendment, all prior art rejections fall, and the present application will be in *prima facie* condition for allowance. Applicants respectfully solicit an early issuance of a Notice of Allowance.

Respectfully submitted,

Date: May 23, 2003

  
Ginger R. Dreger  
Reg. No. 33,055

**HELLER EHRMAN WHITE & McAULIFFE LLP**

**Customer No. 25213**

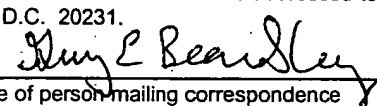
275 Middlefield Road

Menlo Park, California 94025

Telephone: (650) 324-7115

Facsimile: (650) 324-0638

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5/23/03 10:11 AM (39753.0021)

Certificate of Mailing	
Date of Deposit <u>April 19, 2001</u>	Label Number: <u>EL509219083US</u>
I hereby certify under 37 C.F.R. § 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" with sufficient postage on the date indicated above and is addressed to: <u>BOY</u> PATENT APPLICATION, Assistant Commissioner for Patents, Washington, D.C. 20231.	
<u>Guy Beardsley</u> Printed name of person mailing correspondence	 Signature of person mailing correspondence

UTILITY PATENT APPLICATION TRANSMITTAL UNDER 37 C.F.R. § 1.53(b)	
Attorney Docket Number	50025/003002
Applicants	Victor J. Dzau, Gary H. Gibbons, and Ryuichi Morishita
Title	Therapeutic Use of Cis-Element Decoys In Vivo
<b>PRIORITY INFORMATION:</b>	
This application is a continuation of and claims priority from United States patent application 08/524,206, filed September 8, 1995, which is a continuation of 08/144,717, filed October 29, 1993.	
<b>SMALL ENTITY STATUS:</b>	
<input checked="" type="checkbox"/> Applicant claims small entity status under 37 C.F.R. § 1.27.	
<b>APPLICATION ELEMENTS:</b>	
Cover sheet	1 page
Specification	17 pages
Claims	2 pages
Abstract	1 page
Drawing	5 sheets
Combined Declaration and POA, which is: <input type="checkbox"/> Unsigned; <input type="checkbox"/> Newly signed for this application; <input checked="" type="checkbox"/> A copy from prior application 08/144,717 and the entire disclosure of the prior application is considered as being part of the disclosure of this new application and is hereby incorporated by reference therein.	3 pages
Sequence Statement	0 pages
Sequence Listing on Paper	0 pages
Sequence Listing on Diskette	0 diskettes
Preliminary Amendment with Reference	10 pages
IDS	0 pages
Form PTO 1449	0 pages

Cited References	0 references
Recordation Form Cover Sheet and Assignment	0 pages
English Translation	0 pages
Certified Copy of Priority Document	0 pages
Return Receipt Postcard	1
<b>FILING FEES:</b>	
Basic Filing Fee: \$355	\$355.00
Excess Claims Fee: 12 - 20 x \$9	\$0.00
Excess Independent Claims Fee: 3 - 3 x \$40	\$0.00
Multiple Dependent Claims Fee: \$135	\$0.00
Total Fees:	\$355.00
Enclosed is a check for \$355.00 to cover the total fees. Please apply any other charges or any credits, to Deposit Account No. 03-2095.	
<b>CORRESPONDENCE ADDRESS:</b>	
Paul T. Clark Reg. No. 30,162 Clark & Elbing LLP 176 Federal Street Boston, MA 02110 Telephone: 617-428-0200 Facsimile: 617-428-7045	
<b>CUSTOMER NO: 21559</b>	
<div style="display: flex; justify-content: space-between;"> <div> <i>Susan M. Michaud</i>            Signature <i>Susan M. Michaud</i> Reg.No. <i>42,885</i> </div> <div> <i>April 19, 2001</i>            Date         </div> </div>	

\\ntserver\documents\50025\50025.003002 Utility Transmittal Sheet.wpd



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PATENT TRADEMARK OFFICE



DAC/1636 \$

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OFFICE OF PETITIONS

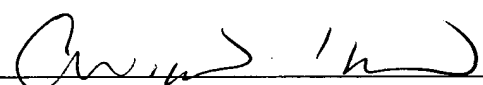
MAIL STOP: DAC  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL

- ☒ Transmitted herewith are the following documents:
- (1) Amendment and Petition under 37 CFR § 1.78(a) (3) to Accept Unintentionally Delayed Priority Claim under 35 USC 120;
  - (2) Check No. 123916 in the amount of \$1,300 for payment of petition fee.
- ☒ The Commissioner is authorized to charge any required fees, or credit any overpayment to Deposit Account No. 08-1641.
- ☒ Attached is a postcard for date-stamped return as confirmation of receipt of these materials.

Respectfully submitted,

Date: May 23, 2003

  
Ginger R. Dreger  
Reg. No. 33,055

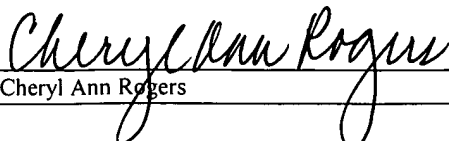
HELLER EHRMAN WHITE & MCAULIFFE LLP

Customer No. 25213  
275 Middlefield Road  
Menlo Park, CA 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on May 23, 2003, with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop: DAC, Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: May 23, 2003

  
Cheryl Ann Rogers

D

**UNITED STATES PATENT & TRADEMARK OFFICE**  
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND											
1 Date of Request: <u>6-12-03</u>		2 Serial/Patent # <u>09/839752</u>									
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT							
	Filing			\$							
	Amendment			\$							
	Extension of Time			\$							
	Notice of Appeal/Appeal			\$							
	Petition		5-28-03	\$ 1300							
	Issue			\$							
	Cert of Correction/Terminal Disc.			\$							
	Maintenance			\$							
	Assignment			\$							
	Other			\$							
			7 TOTAL AMOUNT OF REFUND								
			\$ 1300								
10 REASON:		8 TO BE REFUNDED BY:									
		Treasury Check									
		Credit Deposit A/C #:									
		9 <table border="1" style="display: inline-table; text-align: center; width: 150px;"><tr><td>0</td><td>8</td><td>--</td><td>1</td><td>6</td><td>4</td><td>1</td></tr></table>			0	8	--	1	6	4	1
0	8	--	1	6	4	1					
Petition dismissed as Moot.											
11 REFUND REQUESTED BY:											
TYPED/PRINTED NAME: <u>Karen Creasy</u>		TITLE: <u>Petr Exm.</u>									
SIGNATURE: <u>Karen Creasy</u>		PHONE: <u>705-8859</u>									
OFFICE: <u>DAC for Patents</u>											
***** THIS SPACE RESERVED FOR FINANCE USE ONLY: *****											
APPROVED: <u>[Signature]</u>		DATE: <u>6/24/03</u>									

Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:

**Office of Finance  
Refund Branch  
Crystal Park One, Room 802B**



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Alexandria, VA 22313-1450

**TRANSMITTAL**

- ☒ Transmitted herewith are the following documents for the above-referenced application:
- ☒ Response to Office Action;
  - ☒ Revocation of Prior Powers of Attorney and Appointment of New Attorney of Record.

**STATUS**

- ☒ Applicant is
- ☒ a small entity
  - ☐ other than a small entity.

**EXTENSION OF TIME**

- ☐ Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 410.00	\$205.00
<input type="checkbox"/> three months	\$ 930.00	\$465.00
<input type="checkbox"/> four months	\$1,445.00	\$725.00

Fee \$ \_\_\_\_\_

- ☒ Applicant believes that no extension of time is required. However, this conditional petition is hereby made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

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Date: May 23, 2003

*Cheryl Ann Rogers*  
Cheryl Ann Rogers

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## FEE FOR CLAIMS

- ☐ If an additional extension of time is required please consider this a petition therefor.
- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$\_\_\_\_\_

- ☐ The fee for claims (37 CFR 1.16(b)-(d)) has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)		SMALL ENTITY	<i>OR</i>	OTHER THAN A SMALL ENTITY	
Claims Remaining After Amendment		Highest No. Previously Paid For		Present Extra		Rate	Addit. Fee	Rate	Addit. Fee
Total *	Minus *0*	20	=	0	x9=	\$		x18=	\$
Indep. *	Minus *0*	3	=		x40=	\$		x80=	\$
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+130=	\$		x260=	\$
					TOTAL ADDIT.FEE	\$	<i>OR</i>	TOTAL ADDIT. FEE	\$

- ☒ No additional fee for claims required.
- ☐ Total additional fee for claims required \$\_\_\_\_\_.


### FEE PAYMENT

- ☐ Attached is a check in the sum of \$\_\_\_\_\_ for additional claims fee.
- ☐ Charge Account No. 08-1641 the sum of \$\_\_\_\_\_ for publication fee.

### FEE DEFICIENCY

- ☒ In the event that: a) no check to cover the filing fee is enclosed, b) any above-referenced check is inadvertently omitted or lost, or c) any enclosed check is in an amount less than or greater than the required fee, the Commissioner is authorized to charge any required fees, additional fees, or credit any overpayment to Deposit Account 08-1641. A duplicate of this authorization is enclosed for that purpose.
- ☒ Attached is a postcard for date-stamped return as confirmation of receipt of these materials.

Date: May 23, 2003

  
 Ginger R. Dreger  
 Reg. No. 33,055

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